

line 1. This objection is respectfully traversed. Whether or not this claim contains what is commonly known as a "Markush" group, the present language of the claim is in full compliance with the statute and regulations since there is no requirement for any particular form for presenting a number of alternative embodiments of the invention. The present language of claim 17 is clear, is in fully compliance with the requirements of 35 U.S.C. § 112, second paragraph, and there is no basis to require applicant to use the suggested language. Accordingly, this objection should be withdrawn.

Claims 1-5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Belleville et al. (U.S. Patent No. 6,387,517). The examiner argues that Belleville et al. teaches a composition that may comprise the recited oxides and may comprise those oxides in the proportions recited in claims 3-5, for example. However, the mere fact that a reference may include a broad disclosure that would include the species or subgenus recited in the present claims is not sufficient, in and of itself, to establish anticipation. See MPEP 2131.02. In addition, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to even establish a prima facie case of obviousness. See *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) and MPEP 2144.08(II).

The specific combination of materials recited in claim 1 is neither explicitly or even inherently taught by Belleville et al. Those cases that hold that a general teaching is sufficient to support anticipation require that the specific combination claimed must be at once envisaged in the general teaching of the reference. In addition, cases that have found anticipation are characterized by a small number of alternatives, rather than the huge number of possibilities represented by the facts in this application. As noted in the

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

reply to the previous Office Action, the court has found that a genus that covered only 20 compounds coupled with a description of certain preferences that were present in the claimed compounds was sufficient to support anticipation. *In re Petering*, 133 USPQ 275, 279 (CCPA 1962). Unlike the circumstances in *Petering*, however, there are 2,047 possible combinations of tantalum oxide and one or more of the other 11 oxides taught in Belleville et al. and none of the examples or any other preference described by Belleville et al. contains even one of the three oxides recited in claim 1. The conditions supporting the anticipation rejection in *Petering* are not present in this case. Accordingly, Belleville et al. does not contain a teaching sufficient to anticipate claims 1 and 2.

Claims 3-5, requiring a range amounts of the recited oxides, represent a more significant departure from the teachings of Belleville et al. Again, simply because the recited combinations may fall within the broad scope of the teachings of Belleville et al. is not sufficient to establish anticipation unless the recited combinations would be at once envisaged by a consideration of the teachings in Belleville et al. Not only is there the distinction of the three specific oxides recited in claim 1, for example, but there is an additional limitation of the proportions recited in claims 3-5. Since there is no teaching, or example in Belleville et al. regarding the claimed combination of oxides or the claimed range of concentrations for these oxides, certain selections and decisions based on Belleville et al. would have to be made in order to arrive at the claimed combination. The mere fact that a selection and decision is necessary supports the conclusion that Belleville et al. does not anticipate these claims, and in the absence of any motivation to make the selections required to arrive at the claimed combinations,

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Belleville et al. does not even support a *prima facie* case of obviousness with respect to claims 1-5. Accordingly, the rejection of claims 1-5 should be withdrawn.

Claims 9/1 and 10-14/1 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Rahilly (U.S. Patent No. 4,116,717). The Office recognizes that Belleville et al. lacks reference to sintering of the oxides prior to vaporation, even though this patent acknowledges (column 1) that such process steps are conventionally employed in preparing layers for optical elements. Belleville et al. seeks to avoid the conventional physical processes of sintering and deposition under vacuum, opting instead for the use of an inorganic polymer that is densified and cross-linked by a heat treatment at a moderate temperature or by exposure to ultra-violet rays (Belleville et al. at column 6, lines 38-43). Rahilly does teach that a conventional antireflecting coating such as tantalum oxide or silicon oxide can be applied following sintering (column 3, lines 23-28). Rahilly et al. does not teach that other oxides can or should be present when forming the antireflecting coating. Rahilly uses a process for deposition of the antireflection film that Belleville et al. seeks to avoid, and there is nothing in Rahilly that would motivate a person skilled in the art to select at least the three oxides recited in claim 1 for such a layer or to predict that such a layer containing these oxides could be successfully deposited using sintering and vacuum vaporization techniques.

The examiner has pointed out that both references teach an antireflective coating containing tantalum oxide that would allegedly strongly suggest that the methods used to create the Rahilly antireflective layer would also work for the Belleville et al. antireflective layer. Even assuming that were true for an antireflective coating of

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

tantalum oxide alone, there is nothing in either of these references to suggest that such a procedure would be appropriate or desirable for a coating containing the three oxides recited in claim 1, particularly since the only reference (Belleville et al.) that broadly suggests a combination of oxides teaches away from using a sintering process. There is nothing in this combination of references that would provide the necessary motivation or predictability of success to establish a *prima facie* case of obviousness of the rejected claims. Accordingly, this rejection should be withdrawn.

Claims 15-17/1 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Rahilly and Asai et al. (U.S. Patent No. 5,116,644). In addition to the deficiencies of Belleville et al. and Rahilly discussed above, Asai et al. fails to provide any teaching that would cure these deficiencies or otherwise provide a motivation to select the unique combination of oxides recited in claim 1 to be deposited in the manner recited in claim 9 to meet the limitations of these claims. Accordingly, this rejection should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: Charles E. Van Horn  
Charles E. Van Horn  
Reg. No. 40,266

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com